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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,848	03/29/2006	Klaus Stoll	PP122956APCT	4321
324 7590 12/12/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER LEE, RIP A	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,848

Applicant(s)

STOLL ET AL.

Examiner

Rip A. Lee

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-24 is/are rejected.
- 7) ☒ Claim(s) 1 and 2 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06-16-2006</u> | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 1796

DETAILED ACTION

Claim Objections

1. Claims 1 and 2 are objected to because of the following informalities: Claim 1 recites “A₂ and A₃ are additionally hydrogen,” and claim 2 recites “A₃ is additionally hydrogen.” Since these terms are defined separately from the preceding Markush groups, it is not clear whether these embodiments are optional or required. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1796

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-7 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. 6,469,088).

Lee discloses propylene polymer containing dibenzylidene sorbitol, *N,N'*-bis(3-(3',5'-di-*t*-butyl-4'-hydroxyphenyl)propionyl)hydrazine, *N,N'*-hexamethylenebis(3,5-di-*t*-butyl-4-hydroxyhydrocinnamide, and calcium stearate.

6. Claims 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Matthijs *et al.* (WO 02/14045).

Matthijs *et al.* teaches a polypropylene composition comprising slip agents (oleamide, stearamide, erucamide; page 2), polyethylene wax (pages 2 and 3), and clarifying/nucleating agents (*bis*(*p*-methylbenzylidene)sorbitol, labeled "MDBS" or *bis*(3,5-dimethylbenzylidene)sorbitol dimethyl, labeled "DMDBS"; see pages 3 and 4). Example 1 shows a composition containing oleamide, PE wax, and DMDBS.

7. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Handa *et al.* (U.S. 6,299,801).

Handa *et al.* discloses polyolefin compositions containing dibenzylidene sorbitols, Irganox MD 1024 (col. 19, lines 10-25) and paraffin, polyethylene, and amide waxes (col. 13, line 55 – col. 14, line 13).

Art Unit: 1796

8. Claims 1-15 and 17-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McCullough (EP 911 365).

McCullough teaches a polypropylene composition containing commercially available clarifying agents such as dibenzylidene sorbitol, *bis(p-methylbenzylidene)sorbitol* or *bis(3,5-dimethylbenzylidene)sorbitol* (paragraph [0013]). Compositions also contain an antioxidant which is 1,2-*bis(3,5-di-t-butyl-4-hydroxyhydrocinnamoyl)hydrazine* (paragraph [0015]). Lubricants such as stearamides, oleamides, and erucamides are disclosed in paragraph [0014], line 43. It is maintained that McCullough teaches a small genus of antioxidant which places the claimed species in the possession of the public as in *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under 35 U.S.C. 102. As such, claims to propylenes containing the minimum combination of sorbitol with diacyl hydrazine compound, is anticipated or obvious over the prior art.


As is known in the art, combinations of primary and secondary antioxidants may be used (paragraph [0014]), and the reference cites Irganox 1010 as a useful primary antioxidant. And while the reference does not disclose a combination of sorbitol with diacyl hydrazine and Irganox 1010, it would have been obvious to one having ordinary skill in the art, absent any showing of criticality or unexpected results, to make a composition containing sorbitol as the clarifying agent, and Irganox 1010 as the primary antioxidant, and 1,2-*bis(3,5-di-t-butyl-4-hydroxyhydrocinnamoyl)hydrazine* as a co-antioxidant or secondary antioxidant. Since each type of antioxidant is known to confer specific type of protection to a polypropylene matrix, one having ordinary skill in the art would have found it obvious to select appropriate antioxidants from a finite number of materials set forth in McCullough in order to provide the correct level of stabilization to match the end use of a particular polypropylene matrix. Selection of a known material based on its suitability for its intended use supports *prima facie* obviousness. *Sinclair & Carroll Co. vs. Interchemical Corp.* 325 U.S. 327, 65 USPQ 297 (1945). Moreover, the combination of known elements according to known methods to yield predictable results is well within the level of skill, and thus obvious, to one having ordinary skill in the art.

Art Unit: 1796

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu S. Jagannathan, can be reached at (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



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December 8, 2007